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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/183,819	10/30/1998	THOMAS H. BAKER	6098000SDXH9	3549

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EXAMINER

HUFFMAN, JULIAN D

ART UNIT PAPER NUMBER

2853

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/183,819

Applicant(s)

BAKER ET AL.

Examiner

Julian D. Huffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-11,14-25,27-41 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) 37-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,6,7,9-11,15-25,27-36,43-49 and 52 is/are allowed.
- 6) ☒ Claim(s) 8,14,50 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 37-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8, 14, 50 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regards to claim 8, the disclosure does not support low velocity on the order of a fraction of 13cm (5 inches) per second.

With regards to claim 14, the disclosure does not support the limitation that the low velocity is a fraction of the marking speed.

With regards to claim 50, the disclosure does not support the limitation that the low positioning accuracy is a fraction of said dimension of an individual mark.

With regards to claim 51, the disclosure does not support the limitations that the low velocity is on the order of a fraction of 13cm (5 inches) per second and the low positioning accuracy is a fraction of said dimension of an individual mark.

***Allowable Subject Matter***

4. Claims 1, 2, 6, 7, 9-11, 15-25, 27-36, 43-49 and 52 are allowed.

***Response to Arguments***

5. Applicant's arguments with regards to the 112 1<sup>st</sup>. paragraph rejection of claims 8, 14, 50 and 51 have been considered and are respectfully deemed non persuasive.

With regards to the limitation that the low velocity is a fraction of said marking speed, applicant points to pages 35 and 36 of the disclosure. These pages state that the sensor need not be moved at high speed and moves rather slowly. These relative terms do not relate the speed of the sensor to the marking speed. Claim 14 includes the limitation that "the second carriage scans a sensor at only low velocity", then further adds the limitation that "the low velocity is a fraction of the marking speed". The claim language uses terms similar to the disclosure, since both state that the sensor moves slowly, however, in the claim, applicant added that it moves less than the marking speed. If the use of terms such as low and slow necessarily require a speed less than the marking speed, as applicant requires in their argument, then why must applicant further define what the term means in the claim? Respectfully because relative terms such as "low" and "slow" are not descriptive without a basis for comparison and the

passage cited cannot enable the limitation in question. Additionally, the marking speed is not discussed in the disclosure.

With regards to the limitation of low velocity on the order of a fraction of 13cm (5 inches) per second, applicant stated that this limitation was enabled in the present application since the present application incorporates by reference the Sievert et al. patent which incorporates by reference the Cobbs et al. patent which teaches the limitation in question.

Firstly, essential material may not be incorporated by reference to a U.S. patent or application which itself incorporates "essential material" by reference. See MPEP 608.01(p) I. The limitation in question is essential material since it is in the claim and necessary to describe the claimed invention.

Secondly, applicant provides evidence in the form of the Cobbs et al. reference which teaches printing a test pattern at various speeds, the lowest speed being 13cm (5 inches) per second. Applicant then draws the conclusion that the limitation of moving the sensor at low velocity on the order of a fraction of 13cm (5 inches) per second is therefore enabled (by the aforementioned evidence). Respectfully, applicant's conclusion requires the further evidence that the sensor moves at a velocity which is less than that used during printing. No such evidence is provided in the disclosure, as discussed above.

With regards to the limitation that the low positioning accuracy is a fraction of said dimension, applicant points to page 35, lines 27-31, which state that accuracy need only be sufficient to position the sensor over a relatively large test patch. Nothing in this

passage requires the accuracy to be a fraction of the dimension of a test path, rather all it requires is that it is sufficient so that the sensor may be positioned over a large test patch.

The examiner has reviewed the disclosure and is not aware of any passages which would provide enablement for the limitations in question.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (703)

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308-6556. The examiner can generally be reached Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier, can be reached at (703) 308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722. Faxes requiring the immediate attention of the examiner may be sent directly to the examiner at (703) 746-4386. Note that this number will not automatically send a confirmation that the fax was received.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JH

JH

29 September 2003



Stephen D. Meier  
Primary Examiner